

## **REMARKS**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, claims 1 and 6 have been amended to yet more clearly define the present invention and to eliminate language the Examiner found objectionable. Claims 1 and 6 have also been amended, together with claims 4-5, to correct a spelling error therein. Claims 2-3 have been amended to make them consistent with claim 1 they depend on.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

Specifically, it is respectfully submitted that with objections to claims 1-6 having been overcome as discussed above, claims 1-6 are in condition for allowance.

The Examiner rejected claims 1 and 6 under 35 U.S.C. § 102(a) as being anticipated by Daigneault, U.S. Patent No. 6,609,865 (Daigneault). Claims 2-3, 4 and 5 were rejected under 35 U.S.C. § 103(b) as being unpatentable over Daigneault in view of, respectively, Shinjo, U.S. Patent No. 3,948,141 (Shinjo);

Herr, U.S. patent No. 6,425,718 (Herr) and British Publication GB 2194062 (GB062). It is respectfully submitted that claims 106 are patentable over the cited references.

Specifically, claim 1 recites a measuring device for controlling an installation torque of a fastening element. Daigneault relates to means for indicating a pressure threshold applied to the fastening element. For that reason above, Daigneault is not believed to be particularly relevant to the present invention.

It is a long held view that the preamble is given the effect of a limitation, is deemed essential to point out the invention defined by a claim, and is “considered necessary to give life, meaning and vitality to the claims” when “there inhered in the article specified in the preamble a problem, when transcended that before prior art...” *Kropa v. Robie and Maheman*, 88 U.S.P.Q. 478,481 (CCPA 1951). The same court further stated “The nature of the problem characterized the elements comprising the article, and recited in the body of the claim... So as to distinguish the claim over the prior art.”

An important object of the present invention is a measuring device, elements of which would not soil the visible region of the fastening element.

The object of Daigneault is simply to provide means for a visual indication of a pressure threshold applied to the fastening element. Daigneault does not contribute to the solution of the problem the present invention solves.

According to the present invention, the object of the invention is achieved by providing at least partially transparent covering on the outer surface of indicator means, with the indicator means being visible through a transparent region of the covering. No such covering is disclosed in Daigneault.

On the contrary, in Daigneault, it is the element, the Office Action considers an equivalent of the covering according to the present invention (the actuating surface 40) forms the indication means, with the released fluid remaining on the covering (column 2, lines 30-35). In effect, Daigneault teaches away from solution according to the present invention.

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d

1051, 1053 (Fed. Cir. 1987). The federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . . [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019 ; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Daigneault does not disclose at least partially transparent as claimed. Since Daigneault fails to disclose each and every feature of independent claim 1, Daigneault, as a matter of law, does not anticipate the present invention, as defined by said independent claim.

In view of the above, it is respectfully submitted that Daigneault does not anticipate or make obvious the present invention as defined in claim 1, and the present invention is patentable over Daigneault.

Shinjo, Herr, and GB-062 also do not disclose at least partially transparent covering for indication means.

Claims 2-5 depend on claim 1 and are likewise allowable.

Claim 6 is directed to a fastening system with a measuring device, relies for its patentability on the same inventive features as claim 1 and is allowable for the same reason claim 1 is allowable.

**THIS PAGE BLANK (USPTO)**

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

Alexander Zinchuk

Alexander Zinchuk

Reg. No. 30,541

Date: October 12, 2005  
Abelman, Frayne & Schwab  
666 Third Avenue, 10th Floor  
New York, NY 10017-5621  
212-885-9383

This correspondence is being deposited with the United States Postal Service on October 12, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **ER 842 053 350 US** addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.

Alexander Zinchuk  
Alexander Zinchuk